

REMARKS

I. Claim Status

Withdrawn claims 27-71, 81-104, 111, 122 and 124 are hereby canceled without prejudice to further prosecution in one or more related continuation or divisional applications. Claims 1 and 105 have been amended. Support for the amendments to claim 1 and claim 105 can be found in the Specification at page 15, line 28 and at page 32, lines 5-16. Claims 1-6, 12-17, 19-20, 22-26, 72-78, 105-110, 112-121, 123, 125 and 126 thus are now pending in the present application.

II Withdrawn Objections/Rejections

Applicants' attorney thanks the Examiner for the withdrawal of all of the objections and rejections raised in the previous office actions.

II. New Rejections

A. 35 U.S.C. § 102(e)

Claims 1-2, 12-16, 17, 19-20, 22, 72-76, 78, 105, 110, 112-115, 120-121, 123 and 126 stand rejected as being allegedly anticipated under 35 U.S.C. § 102(e) by Aebersold et al. (U.S. Pub. No. 2002/0076739 A1). This rejection is respectfully traversed in view of the amended claims.

The Aebersold et al. patent publication describes a method of using affinity labeled protein reactive reagents in conjunction with a method for analyzing proteins or protein function in a mixture of proteins. It is respectfully submitted that Aebersold, et al. do not describe a method having the collective combination of steps in Applicants claimed invention.

Claims 1 and 105 have been amended to specify that the gene library is a gene variant library and that the purifying step is not a chromatographic separation step. The Office Action states that the publication describes purification of β -galactosidase using streptavidin-agarose beads as a non-column separated method. Applicants respectfully wish to point out that Aebersold, et al. describe such purification in the context of analyzing samples taken from patients, and do not describe the claimed steps of, for example, providing one or more cell comprising a gene variant library and growing the one or more cell in vitro. See Aebersold publication at page 11,

paragraph 0112. Further, Aebersole et al.'s disclosure of assaying β -glactosidase and N-acetyl-R-D-glucosaminidase does not satisfy the element of a "gene variant library." Accordingly, withdrawal of the rejection under 35 U.S.C. § 102(e) is respectfully requested.

B. 35 U.S.C. § 103

Claims 1-2, 12-17, 19-20, 22-26, 72-76, 78, 105, 110, 112-121, 123 and 126 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Aebersold, et al. (US 2002/0076739 A1) and Siuzdak, et al. In addition, claims 1-6, 12-17, 19-20, 22-26, 72-78, 105-110, 112-121, 123 and 125-126 stand rejected as being allegedly unpatentable over Aebersold, et al., Siuzdak, et al., and Weinberg, et al. (WO 98/15969). These rejections are respectfully traversed.

It is respectfully submitted that the pages of the Siuzdak et al. reference provided by the Patent Office with the final Office Action (only pages 110 and 120 were provided) actually teach away from the claimed method. The top of page 120 begins, "CSF analysis began with preparative liquid chromatography fraction collection." Claims 1 and 105, as amended, specify that the purifying step is not a chromatographic separation step. Moreover, the Weinberg, et al. patent publication does not describe or suggest a method of high throughput mass spectrometry screening that does not utilize chromatography. Neither of the combinations of Aebersold, et al. and Siuzdak, et al. or Aebersold, et al., Siuzdak, et al., and Weinberg, et al. render the pending claims obvious. Accordingly, withdrawal of the rejection under 35 U.S.C. § 103 is respectfully requested.

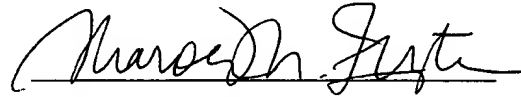
CONCLUSION

In light of the foregoing amendments and remarks, it is believed that the application is in condition for allowance. Accordingly, reconsideration and favorable action on all claims is earnestly solicited. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set forth below. The Commissioner is hereby authorized to charge any deficiency in fees or credit any overpayment to Deposit Account No. 50-0990.

November 12, 2004

MAXYGEN, INC.
515 Galveston Drive
Redwood City, California 94063
(650) 298-5421 (Telephone)
(650) 2-98-5446 (Facsimile)
Customer No. 30560

By:



Sharon M. Fujita
Attorney for Applicants
Reg. No. 38,459